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10/529,268

09/29/2005

Johannes Arndt

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09/23/2008

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EXAMINER

VELASQUEZ, VANESSA T

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

09/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/529,268 | Applicant(s) ARNDT ET AL. | |
| | Examiner Vanessa Velasquez | Art Unit 1793 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 3-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claim 8 is newly added. Claims 3-7 remain withdrawn in accordance with the restriction mailed October 31, 2007. Claims 1, 2, and 8 are presented for examination on the merits.

Status of Previous Objections

The previous objection to the abstract for not commencing on a separate sheet, apart from any text, is withdrawn in view of Applicant's submission of a replacement abstract.

Claim Objections

Claim 1 is objected to because of a typographical error. The content of Mo is "0-0-60." It appears that it should be 0-0.60 in accordance with the originally filed claims.

Claim Rejections - 35 USC § 112, First Paragraph

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the claim recites the term "steel forging." The specification provides support for a die-formed part made by a forging step, but does not support a claim encompassing all or any type of steel forging, which is a broad term. Furthermore, there is neither literal nor explicit support for the term, nor is there a definition in the specification as to what Applicant believes is encompassed by the term. Appropriate correction is necessary.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ochi et al. (JP 07-157824). The claims are rejected on the same grounds set forth in the Office action mailed January 8, 2008.

Regarding the amended feature of claim 1, Applicant is reminded that no patentable weight is given to formulae if the composition has been described in the prior art (*In re Cooper and Foley*, 57 USPQ 117). In the instant case, the composition taught by the prior art either substantially overlaps or wholly encompasses the requisite elements of the claim. For convenience, a table is presented below comparing the ranges of the essential elements of the claimed invention and those disclosed in Ochi et al. (abstract).

| Element | Claim 1 | JP 07-157824 |
|---------|---------------|-----------------|
| C | 0.12 - 0.45 | 0.15 - 0.50 |
| Si | 0.10 - 1.00 | 0.005 - 2.00 |
| Mn | 0.50 - 1.95 | 0.40 - 2.00 |
| S | 0.005 - 0.060 | 0.01 - 0.10 |
| Al | 0.004 - 0.050 | 0.0005 - 0.050 |
| Ti | 0.004 - 0.050 | 0.003 - 0.050 |
| V | 0.10 - 0.40 | 0.20 - 0.70 |
| N | 0.015 - 0.040 | 0.0020 - 0.0200 |

Nb may be present in an amount ranging from 0.001 wt.% to 0.20 wt.% (abstract), which overlaps the claimed range. Specifically regarding the amendments to proviso (2), the amounts of S, Al, Nb, and Ti all substantially overlap the claimed ranges.

Because **utility is found over the entire range of a known composition**, the composition of Ochi et al. would satisfy the equations as claimed. Therefore, the claims remain unpatentable over Ochi et al.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ochi et al. (JP 07-157824).

Regarding claim 8, the steel with the composition disclosed in Ochi et al. (see the composition table in the rejection of claim 1, above) may be subjected to a sub-hot-forging operation, thereby producing a steel that has been forged, or, in other words, a steel forging. The steel may be subsequently shaped into automobile components (para. [0001]).

Response to Arguments

Applicant's arguments filed July 8, 2008 have been fully considered but they are not persuasive.

Applicant primarily argues that Ochi et al. (JP 07-157824) is deficient because the reference does not teach the claimed provisos. The Examiner's remarks regarding the provisos are addressed above in the rejection of claim 1.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanessa Velasquez whose telephone number is

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(571)270-3587. The examiner can normally be reached on Monday-Friday 8:30 AM-6:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached at 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

/Vanessa Velasquez/
Examiner, Art Unit 1793